

REMARKS

Claims 1-21, 23 and 24 are pending in the instant application. The Examiner requires that Applicants elect one of the following groups of claims for prosecution:

1. Group I, claims 1-6 and 8-10 drawn to a surface glycoprotein;
2. Group II, claim 7 drawn to a method of making a surface glycoprotein;
3. Group III, claims 11-15 drawn to a nucleic acid encoding a surface glycoprotein;
4. Group IV, claim 16 drawn to a process for producing a surface glycoprotein;
5. Group V, claims 17-18 and 24 drawn to an antibody to a surface glycoprotein;
6. Group VI, claims 19, 20 and 23 drawn to a method for diagnosing a tumor associated with overexpression of ACA;
7. Group VII, claim 21 drawn to a pharmaceutical composition effective to reduce expression of the nucleic acid sequence encoding the surface glycoprotein ACA; and
8. Group VIII, claim 21 drawn to a pharmaceutical composition effective to reduce the biological activity of ACA.

The Examiner further imposes an election of species requirement as follows:

1. One of the individual Sequence ID NOs:1-11 of claims 5 and 11; and
2. One of the individual cancers of claim 23.

Applicants understand that this is a formality issue as claims 1-4, 6-10, 12-19, 20 and 24 are deemed generic to the individual species. Therefore, the Examiner is required to examine all the species until one is found unpatentable.

Regarding the Restriction Requirement

Applicants hereby respond by electing Group I, claims 1-6 and 8-10 with traverse. Applicants respectfully request reconsideration of the Requirement for Restriction to allow

prosecution of more than one group of claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions with properties so distinct as to warrant separate Examination and Search. The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the claims of the present application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, is in order.

According to the Restriction Requirement, Groups I and V are different inventions, as they relate to structurally distinct molecules. However, Applicants respectfully submit that Groups I and V are not different inventions, since they are merely directed to a surface protein and an antibody to the same. As such, a search of one molecule necessarily entails a search of the other.

Regarding the Election Requirement

The Examiner requires also electing one sequence and one particular cancer for initial searching. Applicants remind the Examiner of the obligation to expand the scope to examine other sequences and other cancers once the first sequence is determined to be patentable. Applicants herein elect with traverse "SEQ ID NO:1" of claims 5 and 11 and melanoma as the cancer of claim 23. Claims 1-4, 6-10, 12-19, 20 and 24 are deemed generic to the individual species. As such, all of the claims pending, namely 1-21, 23 and 24, are believed to read upon the elected species.

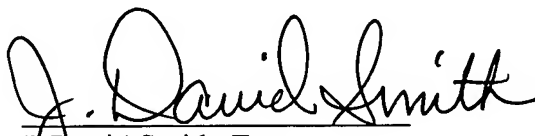
FEES

No additional fees are believed necessary in connection with the present submission; however, should this be in error, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment or to credit any overage.

CONCLUSION

It is believed that all of the claims are patentable and early notification as such is earnestly solicited. If any issues may be resolved by way of telephone, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully submitted,


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